

REMARKS

I. Introduction

The final Office Action of October 30, 2008 has been reviewed and the Examiner's comments carefully considered. The present Amendment amends claims 22 and 36 in accordance with the originally-filed specification. No new matter has been added. The present Amendment also cancels claims 27, 29, and 30. Accordingly, claims 22, 24, 26, 28, 32-34, 36, 40, and 42 are currently pending in this application and claims 22 and 36 are in independent form. The Applicant respectfully requests entry of the present Amendment and favorable reconsideration of the claims.

II. Improper Finality of the Office Action

Initially, Applicant would like to note the above amendments should be entered because the finality of the October 30, 2008 Office Action was premature. Under present practice at the United States Patent and Trademark Office, second actions, or any subsequent actions on the merits, shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement. While the independent claims were amended in the Amendment of May 18, 2007, the Examiner responded by issuing a final Office Action in which he continued to reject the claims under a combination of United States Patent No. 4,175,860 to Bacus, United States Patent No. 4,741,043 to Bacus, and United States Patent No. 5,134,662 to Bacus et al. New grounds of rejection were set forth in the Office Action of October 30, 2008 and it was argued that the amendments set forth in the Amendment of May 18, 2007 necessitated these new grounds of rejection. However, the new grounds of rejection set forth in the final Office Action were not necessitated by the Amendment of May 18, 2007, but rather by the Notice of Panel Decision from Pre-Appeal Brief Review which withdrew the rejection under the Bacus patents and reopened prosecution. Accordingly, the amendments set forth in the Amendment of May 18, 2007 did not necessitate the new grounds of rejection set forth in the final Office Action of October 30, 2008 and the finality of this Office Action should be withdrawn.

During a telephone conversation with the Examiner on February 25, 2009, the Examiner indicated that he would enter the amendments presented hereinabove.

III. 35 U.S.C. §102 Rejections

Claims 22, 24, 26-29, 33, 36, 40, and 42 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,190,632 to Fujimiya (hereinafter "the Fujimiya patent"). In view of the above amendments and the following remarks, the Applicant respectfully requests reconsideration of this rejection. Although the Applicant does not agree with the rejections set forth in the final Office Action of October 30, 2008, the claims have been amended to correspond to the claims as granted in the corresponding European Patent (EP 1 166 162 B1) in order to expedite prosecution.

As defined by amended independent claim 22, the present invention is directed to a device for selecting and recording an image of an irradiated or emissive object comprising complexes of DNA, RNA or proteins. The device includes an immovable object holder for positioning the object in a stationary position, at least one mirror for reflecting an image of the object, a camera, first drive means for displacing the camera substantially parallel to a rotation axis of the at least one mirror, and second drive means for rotating the at least one mirror about the rotation axis which is perpendicular to an optical axis of the camera, thereby displacing the at least one mirror for selecting a part of the image from the reflected image of the object while holding the object in the stationary position. The camera is displaceable in a viewing area in which the image of the object is reflected by the at least one mirror that lies on the optical axis of the camera.

As defined by amended independent claim 36, the present invention is also directed to a method for selecting an image to be recorded with a camera which forms a part of an irradiated or emissive object comprising complexes of DNA, RNA or proteins. The methods include the steps of: A) placing the object in stationary position on an immovable object holder, B) reflecting an image of the object with at least one rotatable mirror that lies on an optical axis of a camera and rotates about a rotation axis which is perpendicular to the optical axis of the camera, and C) selecting with the camera and by displacing the at least one mirror a part of the

image of the object to be viewed from the reflected image while holding the object in the stationary position. The camera is displaced substantially parallel to the rotation axis of the at least one mirror in a viewing area in which the image of the object is reflected by the at least one mirror.

The Fujimiya patent is directed to a multi-colored electrophoresis pattern reading system including an electrophoresis unit (1) and a reading unit (6) disposed separately from the electrophoresis unit (1). The electrophoresis unit (1) includes an electrophoresis unit section (5) having a gel member that serves as a base for electrophoresis and a gel support member for supporting the gel member by a glass panel. The electrophoresis unit section (5) is removed from the electrophoresis unit (1) after electrophoresis has been finished and mounted to the reading unit (6) for reading the resulting pattern of electrophoresis. The reading unit (6) includes an instrumentation body (7). The operation of the reading unit (6) is as follows: laser beams (31) emitted from the light source (21) are scanned with a vibrating mirror (22) and the gel member is exposed to the laser beams (31). The gel member of the electrophoresis unit section (5) emits fluorescence upon irradiation with the spot lights of the scanned laser beams (31). The resulting fluorescence (13) is then received by the light collector (23). The light received by the light collector (23) is converted into electric signals by an optoelectric conversion section (24) and then amplified by an amplifier (25) (*see* FIGS. 1 and 2).

The Fujimiya patent does not teach or suggest at least one mirror displaceable for selecting a part of the image from the reflected image of the object while holding the object in the stationary position as required by independent claims 22 and 36. The Examiner contends that vibrating mirror (22) of the Fujimiya patent corresponds to the at least one displaceable mirror of the present invention. However, the vibrating mirror (22) of the Fujimiya patent is not provided to select a part of the image from the reflected image of the object as required by the independent claims. Instead, this mirror is provided to scan the gel member of the electrophoresis unit section (5) with laser light (31) produced by light source (21). There is no teaching or suggestion in the Fujimiya patent that vibrating mirror (22) selects a part of an image from a reflected image. In fact, the vibrating mirror (22) of the Fujimiya patent cannot perform such a function because only laser light (31) is reflected off of this mirror instead of a reflected image.

Accordingly, the at least one rotatable or displaceable mirror provides a functionality that is not provided by the vibrating mirror (22) of the Fujimiya patent. Not only does the at least one mirror of the claimed invention provide for selecting a part of an image of the irradiated or emissive object, but it also discloses reflecting an image for a camera for recording.

In addition, the present invention is directed to a “device for selecting and recording an image”. The device disclosed in the Fujimiya patent cannot perform such a function. Instead, the Fujimiya patent provides a pattern reading system capable of labeling samples to electrophoresis so as to develop a pattern of electrophoresis. To perform this process, the Fujimiya patent utilizes a vibrating mirror (22) to scan a gel member of the electrophoresis unit section (5). During this scanning, only laser light (31) is reflected off of the vibrating mirror (22). Accordingly, a fundamental difference between the present invention and the Fujimiya patent is that the system of the Fujimiya patent utilizes a vibrating mirror to reflect an excitation source whereas the present invention has a light source that is stationary.

For the foregoing reasons, the Applicant believes that the subject matter of amended independent claims 22 and 36 is not anticipated by the Fujimiya patent. Reconsideration of the rejection of claims 22 and 36 is respectfully requested.

Claims 24, 26, 28, 33, 40, and 42 depend from and add further limitations to amended independent claim 22, amended independent claim 36, or a subsequent dependent claim and are believed to be patentable for the reasons discussed hereinabove in connection with amended independent claims 22 and 36. Reconsideration of the rejection of claims 24, 26, 28, 33, 40, and 42 is respectfully requested.

IV. 35 U.S.C. §103 Rejections

Claims 32 and 34 stand rejected under 35 U.S.C. §103(a) for obviousness based upon the Fujimiya patent. In view of the above amendments and the following remarks, the Applicant respectfully requests reconsideration of this rejection.

Claim 32 depends from and adds further limitations to amended independent claim 22, and claim 34 depends from claim 24 which in turn depends from amended independent

claim 22. These claims are believed to be patentable for at least the reasons discussed hereinabove in connection with amended independent claim 22. Reconsideration of the rejection of claims 32 and 34 is respectfully requested.

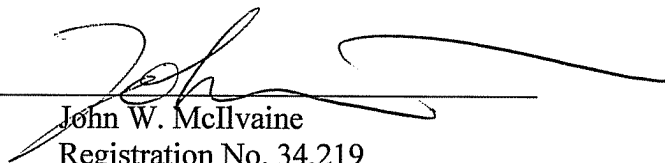
Claim 30 stands rejected under 35 U.S.C. §103(a) for obviousness based upon the Fujimiya patent in view of United States Patent No. 5,998,796 to Liu et al. (hereinafter "the Liu patent"). Claim 30 has been cancelled by the present amendment, thereby rendering the rejection of this claim moot.

V. Conclusion

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 22, 24, 26, 28, 32-34, 36, 40, and 42 are respectfully requested. Should the Examiner have any questions or wish to discuss the application in further detail, the Examiner is invited to contact Applicant's undersigned representative by telephone at 412-471-8815.

Respectfully submitted,
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By _____



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